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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,555	12/28/2001	Bernhard Albeck	970266D1/TL	2595

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EXAMINER
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TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/034,555

Applicant(s)

ALBECK ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/902,453.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/28/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of the invention of Group III, Claim 4, in the reply filed on 1/24/05 is acknowledged.
2. Claims 2, 3, 5 and 6 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/24/05.

### *Priority*

3. This application does contain the necessary reference to the prior application, i.e. 08/902,453, as filed in the preliminary amendment on 12/28/01 in the first sentence of the specification. However, the statement does not provide the current status of the nonprovisional parent application, which matured into U.S. Patent 6,353,996. The current status of the parent application should be included and appropriate correction is required.

### *Specification*

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because the content is not directed to the claimed process and the length appears to be greater than 150 words. Correction is required.

See MPEP § 608.01(b).

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Method of Wiring Electrical Terminals.

***Claim Objections***

8. Claims 1 and 4 are objected to because of the following informalities.

There are several phrases that are awkwardly worded and the following changes are recommended by the examiner to correct these informalities.

In Claim 1, “comprising...invention” (line 14) should be replaced with --the method further comprising--; the phrase of --further including-- should be inserted before “the steps” (line 16); and the term “SBIPC” (line 12) should be --(SBIPC)--.

In Claim 4, “an initial terminal” (line 4) should be recited as --said initial terminal--; “a final wire” (line 10) should be recited as --said final wire--; and --a second-- should be inserted before “one” (line 10).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the phrase “the contact zone” (line 18), as well as the latter recitations of the same phrase, each lack positive antecedent basis. Apparently, the phrase is referring to the previous recitation of “a connection zone” (line 10).

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In Claim 4, it is unclear what is meant by the phrase of “or establishing a through-wire connection” (line 5) because there is no previous step of establishing any through-wire connection.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koller et al 5,442,848 in view of Mews et al 5,480,323.

Koller discloses a method of wiring an electrical terminal comprising: providing a position controllable wiring finger 2 (in Fig. 1) having an insulated wire 5 and a wire outlet 10, a pressure element 19 and a cutting means (blade 12), each of which are movable with respect to the finger; a terminal with a connection zone including a slit blade insulation piercing connector (SBIPC) (in Fig. 1A); positioning the finger spaced from the terminal and outside of the connection zone and portions of the SBIPC; feeding a predetermined length of wire with feed belts 6 from the finger over the pressure element 19 where the wire is positioned adjacent the outlet 10 from the finger (shown in Fig. 1A); causing relative movement towards each other of the finger and the connection zone of the terminal by pressing the wire with the pressing element 19 (see Fig. 4); in establishing a final wire connection, positioning the finger spaced from the terminal and outside the connection zone such that a portion of the wire adjacent the outlet from

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the finger is at a side remote from the connection zone (end portion of wire 5 extending to the left of SBIPC 126 in either Fig. 1 or 4); causing relative movement of the pressure element towards the connection zone and movement relative to the finger, thereby cutting the wire close to the SBIPC by the cutting means 12 (see Fig. 5); and thereafter pressing with the pressing element 19 the wire into the SBIPC while maintaining the finger outside of the connection zone and portions of the SBIPC (see col. 5, lines 11+).

Koller discloses substantially all of the limitations of the claimed manufacturing process except that the connection zone of the SBIPC is located within an insulated housing.

It is conventional and notoriously well known in the art of connecting terminals to wires that SBIPCs in general have connection zones within an insulated housing. As evidence, Mews shows an SBIPC (in Fig. 1) with an insulated plastic housing to support connection zones of terminals and wires.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Koller by including the insulated housing around the connection zone, as taught by Mews, for at least the advantages of supporting the connection zones as well as the terminals and the wires.

***Allowable Subject Matter***

13. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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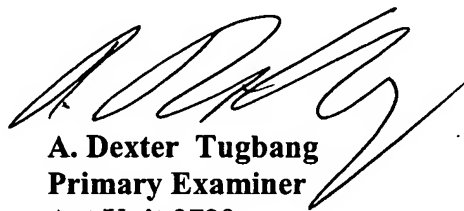
***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**A. Dexter Tugbang**  
**Primary Examiner**  
**Art Unit 3729**

April 18, 2005